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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,450	01/19/2001	Colin Collins	023071111800	8675

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EXAMINER

CLOW, LORI A

ART UNIT	PAPER NUMBER
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1631

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DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/766,450

Applicant(s)

COLLINS ET AL.

Examiner

Lori A. Clow, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 11 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Specification Objections

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (see for example page 7). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claims Objections

Claims 11 and 27 contain the trademark/trade name RepeatMasker™. Claims 12, 28 contain the trademark/trade name BLAST™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a database algorithm and, accordingly, the identification/description is indefinite.

Claims Rejections-35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-12, 18-21, 24-28, 34-39 are rejected under 35 U.S.C. 102(b) as being anticipated by RepeatMasker™ software (RepeatMasker™ documentation: Smit and Green RepeatMasker™ at <http://ftp.genome.Washington.edu/RM/RepeatMasker.html>), first available in June 1997. With regards to claims 1, 18, and 34, the software screens DNA sequences for interspersed repeats and low complexity DNA sequences. The output of the program is a detailed annotation of the repeats that are present in the query (page 1, paragraph 1). Furthermore, the sequences can then be used in databases, such as BLAST™, in order to compare sequences and the data can be used to design primers or oligo probes (page 5, paragraph 4 and page 6, paragraph 6). As required by claims 2 and 19 genomic regions from mammalian sequences are used (including human) (page 3, paragraph 1). As required by claims 4 and 21 the software will output the sequences for each query (page 1, paragraph 5).

Claims 3, 8-10, 24-26, and 36-38 are anticipated by page 3, paragraph 1 in which the software options are described. The particular option **-div** allows the user to limit masking and annotation to a subset of less diverged repeats by choosing maximum divergence levels of the repeat copy to its consensus sequence. Of course, different percent divergences may be used.

Claims 11 and 27 are anticipated from the entire RepeatMasker™ documentation.

Claims 12 and 28 are also anticipated by RepeatMasker™ documentation on page 5.

Claim 39 is anticipated by page 6, paragraph 4 and 5, in that recommendations for how to run a gene prediction sequence using RepeatMasker™ are disclosed.

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Claims Rejections-35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-7, 13-17, 22, 23, and 29-33 rejected under 35 U.S.C. 103(a) as being unpatentable over RepeatMasker™ as applied to claims 1-4, 8-12, 18-21, 24-28, 34-39 above, and further in view of Redasoft™(available September 15, 2000).

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While RepeatMasker™ includes the embodiments listed above, it does not expressly contain instructions to order primers, use Primer3 software, or produce amplification products.

Redasoft™, however, is the first to introduce web browser integration to the scientific software industry and to integrate online ordering of primers in the same program. The particular program utilized to design primer in this software scheme is Primer3, as required by claims 6, 7, 13, 14, 22, 23, 29, and 30. Furthermore the entire premise of this software is to allow users an environment in which they can design primers based upon sequences that were accessed from the web utilizing various unique parameters. The user is then able to directly place an order online within the same program (see description of the software on page 1). As with most primers that are generated, the intention is to produce an amplification product.

While not specifically designated as useful for FISH and CGH probes, it would have been prima facie obvious to one of ordinary skill in the art to use the methods in RepeatMasker™ and Redasoft™ to design FISH probes and CGH probes as required by claims 15-17 and 31-33 and further to combine the technology of RepeatMasker™ with the analysis and order tools available in the Redasoft™ program.

No claim is allowed.

Inquiries

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242, or (703) 308-4028.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (703) 306-5439. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Bill Phillips, whose telephone number is (703) 305-3419, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 26, 2002

Lori A. Clow, Ph.D.

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Lori A. Clow



MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600